

REMARKS

Claims 1, 5-7, 28 and 31-32 are now pending in the application. Claims 2-4 have been canceled and Claims 1, 5, 7 and 18 have been amended. Claims 1, 7 and 28 are independent.

Section 112 Rejection

Claim 28 was rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential steps. Independent Claim 28 has been amended herein to recite the step of "transferring the scanned bar code from the removable memory to a computer network". The claim amendment is believed to overcome the Section 112 rejection and reconsideration and withdrawal of that rejection is therefore respectfully requested.

Prior Art Rejections

Claims 1, 7 and 28¹ were rejected under 35 USC 102(b) as being unpatentable over US Patent 5,774,874 (Veeneman); Claims 3 and 5 were rejected under 35 USC 103(a) as being unpatentable over Veenemen in view of the article 'Swipe Your Shopping' (Field, Chris, March 11, 1998, The Times); and Claims 31 and 32 were rejected as being unpatentable over Veenemen in view of US Patent 6,181,326 (Takahashi).

The cancellation of Claims 2-4 renders the rejection of those claims moot.

The amendments made to each of independent Claims 1, 7 and 28 are believed to render the Section 102(b) rejection moot.

The 103(a) rejections based on the alleged combined teachings of Veenemen, Field and Takahashi are respectfully traversed and reconsideration is requested.

¹ Although Claims 2, 4 and 6 were not listed at the top of page 3 as being rejected, since these claims are discussed in the rejection, it is believed that they were also rejected under Section 102(b). In addition, although the Action recites that these claims were rejected under 35 USC 102(b), it then states "as being unpatentable" (rather than as being "anticipated") – it is believed that these claims were rejected as being "anticipated" – clarification in the next PTO communication is respectfully requested.

Independent Claim 1, as amended herein, is directed to an apparatus for retrieving information related to a consumer product using a consumer product codes. The apparatus includes a portable consumer good *that is a non-electronic device that lacks the capacity for data transmission* and a scanning and storage device in mechanical communication with the portable consumer good. The scanning and storage device includes (i) a scanning element converting a product code symbol into machine readable information representative of the product code, and (ii) a removable memory medium to which the information is stored.

Independent Claim 7 also recites that the apparatus includes a portable consumer good, *that is a non-electronic device that lacks the capacity for data transmission*, and includes an Internet-ready device couplable to one or more Internet-based information servers, the Internet-ready device including a removable memory medium adapted to accept the removable memory medium from the scanning and storage device.

Independent Claim 28 is directed to a method for retrieving information related to a consumer product comprising the steps of integrating a bar code scanner and a removable memory into a consumer good that is *a non-electronic device*, scanning a bar code and storing the scanned bar code in the removable memory, transferring the scanned bar code from the removable memory to a computer network and accessing a web site based on the scanned bar code, wherein the web site includes information related to the selected consumer product.

In the rejection of Claim 3 (the limitations thereof now recited in each of independent Claims 1, 7 and 28) as unpatentable in view of the alleged teachings of Veenemen and Field, the Action takes the position that “Veenemen does not specifically disclose...said portable consumer good comprises a non-electronic device”; that Field “teaches an apparatus, wherein said portable consumer good comprises a non-electronic device (page 1)” (noting that “for a device to be electronic it requires ‘electrons’”) - - the Action then concludes that it “would have been obvious...to have enabled the apparatus of Veenemen with the apparatus of Field to have enabled an apparatus wherein said portable consumer good comprises a non-electronic device” (see first and last sentences on page 6 of Action).

Applicants’ respectfully traverse the allegations and conclusions as to the rejection based on the alleged teachings of Veenemen and Field.

First, the “pen” described in Field is *not* a “a portable consumer good that (1) lacks the capacity for data transmission, and (2) comprises a non-electronic device”.

In fact, as acknowledged in the *previous* Office Action, “Field does not explicitly disclose that the bar code scanner is embedded in a consumer good that lacks the capacity for data transmission”, noting that, in fact, “the pen is capable of *both* wireless and contact-based data transmission” (emphasis added herein). The fact that the pen and mobile phone of Field have the ability to have wireless and contact-based data transmission clearly indicates that these devices, as defined and described by Field, *are “electronic”* – as electron flow is required within each device to accomplish such transmission.

Again, as discussed in paragraph [0013] of Applicants’ specification, the present invention integrates a bar code scanning and retrieval system into a non-electronic consumer device that has an otherwise main and different function or purpose – enabling significantly deeper product penetration into the marketplace. The information scanned by a “non-Internet-ready portable consumer good” can be subsequently transferred to an Internet-ready device by means of removable memory. The non-electronic portable consumer goods include, for example, clothing, pocketbooks, etc.

Field, on the other hand, not only did not appreciate the possibility of an apparatus for retrieving and processing information related to a consumer product having a universal product code, using a portable consumer device that “lacks the capacity for data transmission”, Fields very specifically required a device that “*contains radio technology which will let it connect to the wireless communications networks now operating in some larger stores*”, and notes that “as soon as the phone comes within range, the network will pick up the shopping list and communicate the information to the back office...”.

Again, as acknowledged in the Action, Veenemen fails to appreciate the possibility of an apparatus that is a portable consumer good (such as ‘clothing, pocketbooks, etc’) that is a “*non-electronic device*” .

In fact, one of ordinary skill in the art would find absolutely no teaching or suggestion in either of Veenemen and Field to combine and to modify the alleged teachings thereof in the manner suggested. Of course to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis supplied].

Applicants respectfully submit that even *if* Field taught or suggested a “non-electronic consumer good” (which for the reasons noted above Applicants submit that Field *does not*), the teachings of Veenemen and Field would still fail to meet the requirement of obviousness. Veenemen (which, is directed to a specific “non-consumer” device – a bar code scanner designed only to scan bar codes, with no other “unrelated” functionality, and no suggestion to implement its teachings into a ‘non-electronic’ consumer good) teaches *away from* any inclination to modify its teachings in view of even the *alleged* teachings of Field

Therefore, Applicants submit that Veenemen and Field do not teach or suggest, and one of ordinary skill in the art would not anticipate, in light of their teachings, an apparatus or method such as that recited by Applicant’s amended independent Claims 1, 7 and 28, of a portable consumer good that *is non-electronic and lacks the capacity for data transmission*, including *a removable memory medium to which the product code information is stored*.


For at least the foregoing reasons, Applicant submits that independent Claims 1, 7 and 28, as amended herein, are patentable over Veenemen and Field and reconsideration is respectfully requested.

Claims 5-6 and 31-32 depend from independent Claim 1 or 28 and recite further limitations that even further distinguish over the art of record. It is respectfully submitted that remaining pending Claims 1, 5-7, 28 and 31-32 are patentable over any permissible combination of the teachings of Veenemen and Field.

Request for Telephonic Interview

Should the Examiner maintain the rejection based on Veenemen, Field and Takahashi, despite Applicants' discussion above, Applicants respectfully requests that the Examiner telephone Applicants' undersigned representative at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,



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